REMARKS/ARGUMENTS

In a Final Office Action dated September 19, 2005, all Claims 1-24 and 26-29 were rejected for various reasons. Reconsideration is respectfully requested in view of this amendment.

Note that this amendment is the substantive paper of a Request for Continued Examination (RCE) that is concurrently filed herewith.

Claims 1-24 and 27 stand rejected under 35 USC §101 for being directed to non-statutory subject matter. The Examiner stated that the claim language "raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine ..." in the bottom half of page 4, in paragraph 4 of the Final Office Action.

Applicants respectfully disagree. Specifically, there is no "technological arts" test for patentability under §101. See Ex parte Lundgren, Appeal No. 2003-2088, Application 08/093,516 (BPAI Opinion, Sept. 2005). Instead, under current law, an invention falls within the scope of §101 if the claimed invention transforms or reduces an article to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result. And Claim 1 transforms or reduces one of the first version and the second version (whichever is identified as the release version) to a different state or thing by performing a build on it. In doing so, Claim 1 produces a "useful, concrete and tangible result". Hence Claim 1 is patentable under §101.

At paragraph 4 on page 2 of the Final Office Action, the Examiner stated that the various steps of Claims 1-24 could be done by a person as a mental step or using pencil and paper. Applicants do not agree with the Examiner's remarks, at least because Claim 1 as rejected already required "storing in a **computer** memory" (emphasis added). The Examiner did not explain how a mental step of a person or pencil and paper can store anything in a computer memory.

Even if a claim could be done by a person as a mental step or using pencil and paper, this does not make the claim non-statutory. See the following remarks quoted from the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" which was released in October 2005:

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> It is immaterial whether the process may be performed by some or all steps that are carried out by a human. Claims are not directed to non-statutory processes merely because some or all the steps therein can also be carried out in or with the aid of a human or because it may be necessary for one performing the processes to do some or all of the process steps. The inclusion in a patent of a process that may be performed by a person is not fatal to patentability. Alco Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490, 1496, 1 USPQ2d 1337, 1341 (Fed. Cir. 1987) (citing Diehr, 450 U.S. at 175); see e.g. Smith & Nephew, Inc. v. Ethicon, Inc., 276 F.3d 1304, 61 USPQ2d 1065 (Fed. Cir. 2001) (method claim where all the steps are carried out by a human). Therefore, USPTO personnel should no longer rely on the human step test to determine whether a claimed invention is directed to statutory subject matter.

In the Final Office Action, at the bottom of page 2 in paragraph 4, the Examiner also stated that reciting "a computer implemented method" would make the claim statutory. In this context, the above-cited Guidelines also state:

> Whether a claim recites a machine implemented process is not determinative of whether that process claim is statutory. Such a test would recognize that an abstraction merely implemented on a computer is statutory. An example will illustrate the point. Assume that y = 2x + C, where x and C are positive real numbers, is nothing more than an abstract idea. The claim recites: a computer- implemented process comprising providing x and C defined as positive real numbers, multiplying x by 2 to get Z and determining y by adding C to Z. Thus, the claim is nothing more than an abstract idea which is machine implemented and such a claim is not statutory. See, e.g., Benson, 409 U.S. 63, 175 USPQ 673 (finding machine-implemented method of converting binary-coded decimal numbers into pure binary numbers unpatentable). However, using the machine implemented test, the claim would be found to be statutory. The Federal Circuit held that the mere manipulations of abstract ideas are not patentable.

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> Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58. If a claimed process manipulates only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the claim is not being applied to appropriate subject matter. Schrader, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. The Federal Circuit also recognizes that the fact that a nonstatutory method is carried out on a programmed computer does not make the process claim statutory. Grams, 888 F.2d at 841, 12 USPQ2d at 1829(claim 16 ruled nonstatutory even though it was a computer-implemented process).

Nonetheless, to expedite prosecution of Claim 1 over prior art, Applicants have amended Claim 1 by adding the phrase "computer-implemented" to the preamble. In view of all the above remarks, Applicants respectfully request the Examiner to withdraw the rejection of Claims 1-24 over 35 USC §101. Claim 27 has been canceled. Therefore, all issues raised by the Examiner under 35 USC §101 have been addressed.

Claim 1 was rejected for anticipation by US Patent 6,282,709 granted to Reha. However, Reha does not anticipate for a number of reasons. First, Reha fails to disclose a process (called "staging") which requires forming an **association** between a version (on the server) and a time in future until when that version is not to be released. Dates associated with versions in Reha's server are release dates, which appear to be dates in the past, relative to a current time of update by the client. For example, at column 4, line 41, Reha states that the date of a version is its "date of release". There appears to be no teaching, explicit or inherent, that Reha's server may hold a yet-to-be-released version, i.e. prior to its release date, and that such a version is associated with a future date of release.

The Final Office Action cites to Reha's col. 10 lines 16-30 for describing a software update manager that performs an automatic periodic update, which inherently requires a time in future. See page 8 of the Office Action, item 1. Reha's text in column 10, lines 16-30 is reproduced below:

> Software update manager 12 includes an optional scheduler that allows selected software components to be scheduled for periodic updates. This scheduler allows for automatic, periodic checks for down rev software and also for software to be downloaded during non-peak connections times,

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> thereby making the system even more user friendly. The optional scheduler allows software update manager 12 to run in a "quiet mode". In this mode, software update manager 12 starts up and connects to a software update server 14, performs a software component verification and logs the results of the verification. This log file will be read the next time the user runs software update manager 12 or displays an icon to the user, via GUI 16, to indicate that there are pending software component files that may require updating. The user can then decide to update any component files.

As seen from the above text, Reha at most discloses a schedule for a user's computer (which contains the software update manager) to check if any files within the user's computer may need to be updated. On such a schedule, each client checks for existence of versions on the server that have been most recently released (after that client's last update). Hence, one client's schedule is not associated with any dates in the server itself, i.e. release dates of versions. There is no indication whatsoever by Reha that a future date inherent in a client's schedule is to be used as the release date of a version.

Second, Reha fails to show that at a current time, when a version stored on the server, at that current time the version is not to be released until a future date for release. Reha's method appears to make the version available for download whenever it is on the server, at least because from among several clients, any one client can check as soon as the version is placed on the server. Reha explicitly states that whichever most recent version is currently present is identified for download, in column 3 line 65 to column 4 line 7 – which is cited in item 3) on page 8 of the Final Office Action. Reha's text in column 3 line 65 to column 4 line 7 is reproduced below (emphasis added):

> Software component definition file 20 contains a list of software component files that are ***currently*** the most recent versions of the various software components. In the exemplary embodiment, the software component definition file 20 also contains the history of the various software components. For example, the software component definition file 20 may contain the name and latest version number of a particular vendor's display driver software, as well as version numbers and dates of previous versions of the display driver software.

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Suppose Reha's "currently the most recent version" methodology is applied to an illustration that is shown in FIG. 3 of the current patent application. It can be seen from FIG. 3 that at current time 24C, Reha's method identifies versions 23B, 26B and 25D as release versions if currently these are the most recent versions existing on the server.

In contrast, as described in the specification of the current application at page 10 line 19 to page 11 line 2, when using the method of Claim 1 versions 23A, 26A and 25A (FIG. 3) are identified as release versions using associations between versions and corresponding times when the versions are to be released. This identification happens because versions 23B, 26B and 25D are not to be released until the release date 24B, which is yet to occur relative to current time 24C. Reha fails to disclose or suggest any future times for release associated with versions to be released on the server.

Third, if a date when a version is placed in Reha's server (i.e. Reha's release date) is replaced by a future date (of an update schedule in one of the clients), Reha's method will no longer identify the most recent versions, as shown in the example discussed above. Specifically, referring to FIG. 3 of the current application, although 23B, 26B and 25D are the most recently modified versions (relative to current time 24C), they will no longer be identified. Hence, combining Reha's teachings in column 10 with Reha's teachings in column 4 will no longer identify "currently the most recent version". Therefore, such a combination teaches away from the explicit statement made by Reha (see above-quoted text from column 3 line 65 to column 4 line 7 in Reha's patent).

Fourth, there is no indication by Reha, as to which client's schedule (if any, from among multiple clients that check the server for updates) is to be selected when making a future time's association with the version being placed on the server. Moreover, there is no indication by Reha that the release date is further "selected", to be one of the future dates in the selected client schedule. The Final Office Action does not address a corresponding limitation in Claim 1. Note that Claim 1 broadly covers both manual selection and automatic selection of a time for release, as described in the specification, at page 7 lines 14-15 and 21-22. Note further that Claim 1's second time

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In view of the above explanations, Applicants respectfully request the Examiner to withdraw the anticipation rejection of Claim 1 over Reha's patent. Claims 2-24 are believed to be patentable for one or more reasons of the type discussed above.

Claim 1 is amended to remove the limitation of periodicity on the plurality of times because this limitation does not distinguish over Reha's schedule which is also periodic. Therefore, Claim 1 as now recited covers use of a plurality of times in future that are aperiodic. For support, see page 6, lines 17-18 of the specification. The periodic limitation has been moved to new Claim 30 which depends from Claim 1 and hence narrows the scope in Claim 1.

Although Claims 2-6, 10-14, 16, 21-24 and 26, 27 and 29 were rejected for anticipation, Applicants re-iterate that explicit limitations in these claims are not disclosed by Reha, for example, "database" in Claim 5 and "milestone time" in Claim 13. In item 4) in page 8, the Final Office Action stated that such claim limitations are found elsewhere in Reha's patent, e.g. column 10 lines 16-30 which has been reproduced above (on pages 10 and 11 in the current Amendment). Nothing in this text quoted from Reha's column 10 explicitly nor implicitly indicates a "database" or a "milestone time." The citation to Reha's column 10 completely fails to support an anticipation rejection of Claims 5 and 13.

Claim 4 was rejected in the Final Office Action (in the middle of page 4 thereof) as being anticipated by Reha's column 4 lines 35-42 and lines 49-58 which are reproduced below:

> A "What's New" text file is then defined at step 202 for each of the software components listed in step 200. In the exemplary embodiment, the What's New text file describes the history of the particular software component. For example, this file may include information regarding all the previous versions of the particular component including version number and date of release. ...
>
> This step includes identifying the OEM's product version for the latest release of each particular software component. At step 208, the version checking method for the software component files is defined. This step includes defining the number of files to be version checked, the version checking method and version checking method parameters.

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> For example, the version checking method can include any of the following: 1) check local file(s) size and time and date stamp; 2) check version resource embedded in the file;

As seen from the above text, Reha's text in column 4 at most discloses dates of release, which are dates in the past as noted above, because Reha's method is for assisting a user to download software that has been released.

There is no indication by Reha, at least not in column 4 lines 35-42 and lines 49-58, that anything is done when a first time in future, which is associated with a given version, passes. There is certainly no indication that when this happens, a new association is to be automatically stored between that given version and another time.

The activity covered by Claim 4 is best illustrated with an example, assuming current time is Monday, and a version is associated with this upcoming Wednesday midnight as the time in future for release of the version. In this example, when the current time does becomes this Wednesday midnight, then the version is automatically associated with the next Wednesday midnight as the third time that is to occur immediately thereafter, assuming periodicity of a week. For support, see the specification at page 15 line 30 to page 16 line 8. No automatic propagation of a version, from one release time to another release time, is disclosed or suggested in the above-quoted text from column 4 in Reha's patent.

Regarding the rejection of Claim 11 at the bottom of page 4 of the Final Office Action, Applicants respectfully submit that there is no mention whatsoever (neither implicit nor inherent) by Reha about storing two different types of times for a given version of a component, one of which is a current time, and another of which is future time. The Final Office Action's citation to column 3 lines 55-67, column 4 lines 35-42, lines 49-58, col. 5 lines 4-10 and lines 57-67 does not disclose the association of a version with two times.

Claims 21, 22, 23 and 24 were all rejected in the bottom half of page 5 of the Final Office Action, based on the following citations to Reha's patent: (col. 3 lines 55-67, col. 4 lines 35-42, lines 49-58, col. 5 lines 4-10, lines 57-67). As noted above, Reha fails to disclose or suggest that a future time is associated with a component version for release. Therefore, Reha fails to disclose or suggest that two different versions can be identified as the release version, depending on the current time. For example, a first version is

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identified if the current time is between the first time and the second time, and a second version may be identified if the current time is after the second time (in the event that the second time is after the first time). As noted above, Reha's client update method identifies a second version as soon as the second version is present in the server, because the second version is the most recent version.

Also as noted above, Reha fails to disclose or suggest that there is any time dependence in associating his date of release with the version being released. In contrast Claim 23 requires that a second association identifying a second time is stored prior to occurrence of the second time, and Claim 24 requires that subsequent to occurrence of the second time storing of the second association is performed as an exception.

Although Reha discloses manual approval by a user, Reha's method solicits approval from the user for updating of software in the client. There is no motivation or suggestion by Reha that such a manual approval feature in the client should be implemented in a server. There is no indication by Reha for an exception depending on whether the release time of a version occurs before or after the current time.

Regarding dependent claims 6, 9, 17-20, Applicants first note that these claims are already patentable by virtue of patentability of Claim 1 from which they all depend. In view of patentability of these claims, there is no need for Applicant to traverse remarks in an office action specific to these claims, because the remarks are rendered moot by patentability of Claim 1 (and therefore all its dependent claims). To expedite prosecution, Applicants now address the statement at the top of page 9 of the Final Office Action -- namely that "Applicant failed to point out the errors in the motivation statements".

In the Amendment (of July 3, 2005), Applicants did not make a general allegation that these dependent claims define a patentable invention, i.e. without reference to the assertion of Official Notice. If Applicants did not refer to the Official Notice, then as per MPEP the attempted traversal may be inadequate. However, in the Amendment (of July 3, 2005), Applicants made explicit reference to the Official Notices. Specifically, in the bottom half of page 13 of the Amendment dated July 3, 2005 Applicants stated that there was no prior art citation for motivations to add various features (as recited in Applicants' claims) to Reha's invention. In that Amendment (of July 3, 2005), Applicants further requested evidence for each Official Notice.

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Hence the Amendment (of July 3, 2005) made a bona fide attempt to advance prosecution of the application. Applicants respectfully note that the errors in the Official Notices and motivation statements were identified as follows: the statements were not supported by any factual evidence whatsoever. In view of these prior remarks in the Amendment (of July 3, 2005), Applicants believe they did adequately traverse the Official Notices as well as motivation statements. Hence, Applicants hereby state that no admissions have been made. In the unlikely event that any admission appears to have been made, such admission is hereby withdrawn and Applicants hereby respectfully traverse each of Official Notices (for lack of evidence) and motivation statements (also for lack evidence), with further traversal in detail in the following paragraphs.

The Official Notice and motivation statements are not only unsupported, they appear to be inconsistent with Reha's patent. Specifically, in rejecting Claims 6 and 17 in the middle of page 6, the Final Office Action stated "storing/receiving an identity of a person responsible for development of software was well known in the art. ... obvious to incorporate the teaching ... into Reha because it provides a complete record of software development history that can be made available for later use, such as modification or consultation purpose."

Reha teaches the opposite by stating that his users do not have to know the current version of the software running on their computers (column 10 lines 41-44). Without knowing the current version, Reha's users are not expected to communicate with the developer, because the developer is unlikely to be helpful without knowing which version is running. Note that Reha's method is also used by in-house users for testing purposes (see column 10 lines 7-15), and yet Reha does not state that the identity of a person responsible for development of software is stored for display to such in-house users. Therefore, a skilled artisan may infer that some other mechanism is used when in-house users communicate with the developers.

Claim 9 was rejected in the bottom half of page 6 of the Final Office Action for reasons similar to those discussed above, because the same motivation is provided i.e. "modification or consultation purpose" which has been discussed above. Therefore, no further response is needed from Applicants.

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Moreover, in rejecting Claims 18, 19 and 20, the Final Office Action stated at the bottom of page 6 and top of page 7 that "selecting a convenient time to comparing versions of software was well known in the art ... obvious to incorporate the teaching ... into Reha because one would want to perform this function at a convenient time." These statements by the Examiner are inconsistent with Reha's method for updating a user's computer "during non-peak connections times" (column 10, lines 20-21). Specifically, as is well known to any system administrator, Tuesday, Wednesday and Thursday fall in the middle of a week and are normally considered "peak" times of a week for computer usage. In contrast, non-peak times (as per Reha), of a normal week occur in the weekend, i.e. Saturday and Sunday, and in case of long weekends may also be include Monday and/or Friday. Therefore, Reha's non-peak times disclosure teaches away from the times proposed in the Final Office Action for the rejection of Claims 18, 19 and 20.

Claim 28 was rejected for the same reasons as Claims 1, 3, 5, 7. See the bottom of page 5 of the Final Office Action. However Reha fails to disclose or suggest the use of future times as noted above. Specifically, Reha's memory holds a version and a date of release, which is typically a current time when the version is placed on the server and made available for release. Hence Reha fails to disclose or suggest Claim 28's memory holding a version of a component and a time in future.

Also as noted above, Reha discloses using the most recent version of a component, regardless of periodicity with which client computers check for updates. Hence, Reha also fails to disclose or suggest the means for determining a time most recent in the past that is separated by a common period from a next upcoming time among a series of future times. Reha may at most disclose a comparison means for comparing each version's release time with the current time. There is no suggestion by Reha for a means to compare the release time associated with a version with the time identified by the determining means and in case of a match, to supply that version as the release version.

Hence, Applicants respectfully request the Examiner to withdraw the prior art rejection of Claim 28 over Reha's patent. Claim 29 depends from Claim 28 and is therefore believed to be patentable for one or more reasons discussed above for Claim 28.

New Claims 30-37 are added herewith. Claims 30 and 31 are believed to be patentable by virtue of their dependence on their respective independent claims.

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Moreover, Claims 32-37 are supported throughout the originally-filed specification. For example, see FIG. 3 and the related description of: computers 21A-21P covered by the claimed "first computers", computer 20 covered by the claimed "second computer" as recited in Claim 32. Also, see FIG. 4 and the related description in the specification at page 13, lines 7-15 for support of Claims 36 and 37.

Accordingly, Applicants respectfully request allowance of all pending claims. Moreover, Applicants hereby respectfully request the Examiner to call the undersigned at (408) 982-8203 to schedule an **Examiner Interview** prior to issuance of the next Office Action.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office to the fax number 571-273-8300 on December 18, 2005 .

S. Omkar — Dec 18, 2005

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